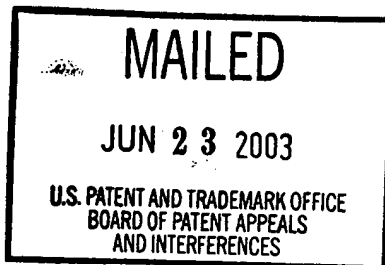


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte EUGENE S. DUDASH et al.

Appeal No. 2003-0514
Application No. 09/820,147

ON BRIEF

Before STAAB, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 to 18. Claims 19 to 21, the only other claims pending in this application, have been withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellants' invention relates to a method of attaching a head rest guide tube to a vehicle seat back frame (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 13 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over the Appellants Admitted Prior Art (AAPA) in view of U.S. Patent No. 3,286,539¹ to Loper et al. (Loper).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 14, mailed October 1, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 13, filed September 16, 2002) and reply brief (Paper No. 15, filed December 9, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art, and to the respective

¹ Issued November 22, 1966.

positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 13 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The independent claims on appeal

Claims 13, 14 and 17 read as follows:

13. A method of attaching a head rest guide tube to a seat back frame having a substantially flat section having opposing sides with an aperture formed therethrough, the method comprising:
 - (a) inserting the guide tube into the aperture; and
 - (b) swaging the guide tube over the flat section of the seat back frame, whereby to secure the guide tube within the aperture.

14. A method of attaching a head rest guide tube to a seat back frame having an aperture extending therethrough, the method comprising:
inserting the guide tube into the aperture; and
swaging the guide tube to form a swaged portion engaged with the seat back frame to thereby secure the guide tube to the seat back frame.

17. A method of attaching a head rest guide tube to a seat back frame having a flat portion, the flat portion having an aperture extending therethrough, the method comprising:
forming a first radially extending swaged portion on the guide tube;
inserting the guide tube into the aperture; and
forming a second radially extending swaged portion on the guide tube such that the flat portion extends between the swaged portions, and such that the swaged portions abut the flat portion to thereby secure the guide tube to the seat back frame.

The applied prior art

The AAPA discloses that it is known to provide openings in the back frame tube of a seat back frame and securing head rest guides tubes in apertures therein by welding. See Preliminary Amendment (Paper No. 6), page 2, first full paragraph.

Loper discloses identical pulley halves 10 dimensioned for sliding contact with a tubular hub element 13 preformed with a single bead shoulder portion 14 by conventional means prior to assembly. A second bead element 19 is formed on the tubular hub element 13 as shown in Figures 2-4 to form the pulley shown in Figure 1. Loper teaches that his pulley construction is an improvement over a pulley construction

in which the hubs were tubular screw machine parts including shoulders and threaded nut elements for pressing the hub engaging portions of the pulley halves together.

The examiner's rejection

In the rejection before us in this appeal, the examiner determined (answer, p. 4) that

it would have been obvious to one of ordinary skill in the art at the time of invention to attach the guide tubes of AAPA to the frame by swaging instead of welding, in light of the teachings of Loper, in order to more securably retain the guide tube within the aperture of the frame.

The appellants' position

The appellants argue (brief, pp. 4-5) that the examiner has failed to establish proper motivation for combining AAPA with Loper as set forth in the rejection under appeal.

Our determination

In applying the test for obviousness under 35 U.S.C. § 103, we conclude that there is no motivation or rationale² in the applied prior art for a person of ordinary skill in

² When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the applied prior art to make the selection made by the appellants. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting

(continued...)

the art at the time the invention was made to have attached the guide tubes of AAPA to the frame by swaging. In that regard, we note that the applied prior art does not teach that swaging provides better securement than welding and therefore the examiner's stated motivation to have modified the AAPA does not come from the applied prior art. Moreover, the applied prior art does not establish that swaging and welding are well known alternatives in the art of securing a tube within an aperture of a frame.

For the reasons set forth above, the examiner has not established a prima facie case of obviousness with respect to the claims under appeal. Accordingly, the decision of the examiner to reject claims 13 to 18 under 35 U.S.C. § 103 is reversed.

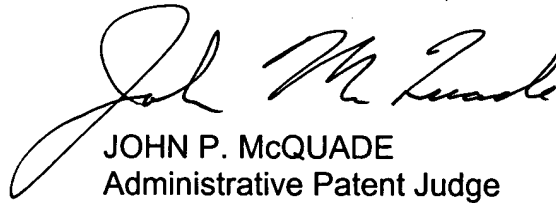
²(...continued)
elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).


CONCLUSION

To summarize, the decision of the examiner to reject claims 13 to 18 under 35
U.S.C. § 103 is reversed.

REVERSED


LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

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